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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/687,346	10/16/2003	Torsten Kluge	81044479	7406

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EXAMINER

ESHETE, ZELALEM

ART UNIT PAPER NUMBER

3748

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/687,346

Applicant(s)

KLUGE, TORSTEN

Examiner

Zelalem Eshete

Art Unit

3748

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 11-14 is/are rejected.
- 7) ☒ Claim(s) 6-10 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 09/22/2003.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4,13,14 are rejected under 35 U.S.C. 102(b) as being anticipated by SRI.

Regarding claims 1,2,13,14: SRI discloses a method and a valve device, comprising: a movable valve element the movable valve element further comprising at least one artificial muscle element coupled to the valve element, in that SRI discloses artificial muscle or electroactive material used as actuators for valves (see paragraph 5). SRI also discloses the artificial muscle element is capable of being controlled by an electrical signal (see paragraphs 3-5).

Additionally, a preamble “in internal combustion engine” to claim 14 is denied the effect of a limitation where the claim is drawn to a structure and the portion of the claim following the preamble is a self contained description of the structure not depending for completeness upon the introductory clause, clearly the claims of record do not rely on the introductory clause for completeness. See *Kropa v. Robie*, *supra* at 480. See also *Ex parte Mott*, 190 USPQ 311, 313 (PTO Bd. of App. 1975).

Regarding claim 3: SRI discloses the artificial muscle element is capable of contracting and expanding (see paragraphs 3-5).

Regarding claim 4: SRI discloses the artificial muscle element contains polymer gels as active elements (see paragraphs 3-5).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over SRI in view of Saunders (6,310,583).

SRI discloses the claimed invention as recited above; however, fails to disclose the artificial muscle element contains carbon nanotubes as active elements.

However, Saunders teaches carbon nanotube artificial muscles are a new synthetic muscle, when properly configured and stimulated perform mechanical work (see column 4, lines 2 to 6).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify SRI's system by providing carbon nanotube artificial

muscles as taught by Saunders in order to take advantage of the newly available synthetic muscles that can perform mechanical work as taught by Saunders.

5. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over SRI in view of Klopotek (6,730,123).

SRI discloses the claimed invention as recited above; however, fails to disclose the valve element is designed as a pivotally movably mounted flap.

However, Klopotek teaches interchangeable use of flap valves, ball valves, nozzle valves etc. (see column 9, 35 to 39). Klopotek also teaches using the artificial muscle or electroactive polymer as actuating element (see column 14, lines 25 to 30).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to extend the application of SRI's system of valves to that of various valve types including flap valves as taught Klopotek in order to apply the system to wide variety of valves that can be interchanged depending upon the application.

6. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over SRI in view of Pelrine et al. (6,628,040).

SRI discloses the claimed invention as recited above; however, fails to disclose the valve element is comprised of the artificial muscle element.

However, Pelrine teaches the valve may include artificial muscle or electroactive polymer transducer (see column 16, lines 7-11).

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the system of SRI by providing a valve element that include artificial muscle element as taught by Pelrine in order to take advantage of contraction/expansion property of artificial muscle.

#### Allowable Subject Matter

7. Claims 6-10 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

#### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Zelalem Eshete whose telephone number is (703) 306-4239. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Denion can be reached on (703) 308-2623. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Zelalem Eshete  
Examiner  
Art Unit 3748

Z

  
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